UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/852,774	05/10/2001	Rabindranath Dutta	AUS920010181US1	5095

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EXAMINER
YIGDALL, MICHAEL J

ART UNIT	PAPER NUMBER
2122	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/852,774	DUTTA ET AL.
	Examiner	Art Unit	
	Michael J. Yigdall	2122	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 August 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some *   c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   Applicant's amendment and response filed on August 31, 2004 has been fully considered. Claims 1-27 remain pending.

Response to Arguments

2.   Applicant's arguments have been fully considered but they are not persuasive. The arguments regarding Fiske (Applicant's remarks, pages 10-11) are moot in view of the new ground(s) of rejection, as set forth below.

3.   In response to Applicant's arguments regarding Fiske, Parthesarathy and Othmer (Applicant's remarks, pages 11-12), the recitation of an "application service provider environment" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

4.   In response to Applicant's argument that there is no suggestion to combine the references (Applicant's remarks, page 12), the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988), and *In re Jones*, 958 F.2d 347,

21 USPQ2d 1941 (Fed. Cir. 1992).

Note that Applicant's arguments regarding Fiske are moot in view of the new ground(s)

of rejection based on D'Souza.

In this case, Parthesarathy teaches a means by which to notify the user of an application

that an update to the application is available (column 6, lines 11-15). An advantage of the

notification feature is that the user is automatically notified of the update whenever the

application is used (column 2, lines 3-7). In contrast to Applicant's assertion (Applicant's

remarks, page 11), the notification feature does not intrinsically require the application to be

upgraded. Parthesarathy expressly discloses that the user may postpone the update or even

prevent the update entirely (column 6, lines 15-22).

Othmer teaches a means by which to receive feedback from a user who is testing an

application (column 1, lines 30-40). The feedback is automatically received and classified, and

errors and problems are automatically characterized (FIG. 2). An advantage of the feedback

feature is that bug-tracking systems and engineers are automatically notified according to the

nature of the feedback (column 2, lines 40-57).

D'Souza teaches a method for improving reliability while upgrading an application in a

server cluster (abstract). D'Souza discloses a certification process in which the new version of

the application is gradually tested to determine whether the upgrade is reliable (column 14, lines

9-30). One of ordinary skill in the art would have been motivated to supplement D'Souza with

the notification feature of Parthesarathy, so that users accessing the application could be

automatically notified of the upgrade. One of ordinary skill in the art would have been further

motivated to supplement D'Souza and Parthesarathy with the feedback feature of Othmer, so that

the users could send feedback to automatically inform the engineers of problems affecting the

certification process. See the claim rejections below.

Specification

5.   The objection to the abstract is withdrawn in view of the amendment.

Claim Rejections - 35 USC § 112

6.   The rejection of claims 5, 14 and 23 under 35 U.S.C. 112, second paragraph, is

withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

8.   Claims 1, 3, 4, 10, 12, 13, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Pat. No. 6,453,468 to D'Souza (art made of record, "D'Souza" herein) in

view of U.S. Pat. No. 6,353,926 to Parthesarathy et al. (art of record, "Parthesarathy" herein).

With respect to claim 1 (currently amended), D'Souza discloses a method for processing

an upgrade version of a base application accessed by a user from an application service provider

(see, for example, FIG. 2 and column 6, line 66 to column 7, line 6, which shows processing an

upgrade version of an application from an application service provider *per se*, and see, for example, column 1, lines 20-25, which further shows Internet-based applications), said base application being accessible at a first network address (see, for example, column 14, lines 1-12, which shows that the base application is available on a first server, i.e. at a first network address), said method comprising:

(a) installing said upgrade version at a second network address (see, for example, column 14, lines 12-21, which shows loading or installing the upgrade version on a second server, i.e. at a second network address).

Although D'Souza discloses a certification process for testing the application at the second network address (see, for example, column 15, lines 45-60), D'Souza does not expressly disclose:

(b) notifying said user that said upgrade version is available for testing at said second network address.

However, Parthesarathy discloses notifying the user that an update is available (see, for example, column 6, lines 11-15), such that the user can be automatically notified of the update whenever the application is used (see, for example, column 2, lines 3-7). The user may postpone the update or even prevent the update entirely (see, for example, column 6, lines 15-22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the application upgrade and certification process of D'Souza with the notification features taught by Parthesarathy, for the purpose of automatically notifying the user of the upgrade when the application is accessed.

D'Souza in view of Parthesarathy further discloses:

(c) enabling said user to access said upgrade version at said second network address (see, for example, D'Souza, column 15, lines 45-60, which shows enabling the user to access the upgrade version at the second network address); and

(d) enabling said user to run said upgrade version with user's data at said second network address without affecting said base application at said first network address (see, for example, D'Souza, column 16, lines 29-50, which shows enabling the user to run the upgrade version at the second network address without affecting the base application at the first network address).

With respect to claim 3 (original), D'Souza does not expressly disclose the limitation wherein said notifying is accomplished by effecting a notification screen display on a display device of said user.

However, Parthesarathy discloses notifying the user that an update is available (see, for example, column 6, lines 11-15), such that the user can be automatically notified of the update whenever the application is used (see, for example, column 2, lines 3-7). The user may postpone the update or even prevent the update entirely (see, for example, column 6, lines 15-22). Parthesarathy further discloses the limitation wherein said notifying is accomplished by effecting a notification screen display on a display device of said user (see, for example, FIG. 5, which shows an exemplary notification screen).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the application upgrade and certification process of D'Souza with the notification features taught by Parthesarathy, for the purpose of automatically notifying the user of the upgrade when the application is accessed.

With respect to claim 4 (original), D'Souza does not expressly disclose the limitation wherein said notification is provided in response to a user request for access to said base application.

However, Parthesarathy discloses notifying the user that an update is available (see, for example, column 6, lines 11-15), such that the user can be automatically notified of the update whenever the application is used (see, for example, column 2, lines 3-7). The user may postpone the update or even prevent the update entirely (see, for example, column 6, lines 15-22). Parthesarathy further discloses the limitation wherein said notification is provided in response to a user request for access to said base application (see, for example, column 10, lines 8-20, which shows providing the notification when the user accesses the application).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the application upgrade and certification process of D'Souza with the notification features taught by Parthesarathy, for the purpose of automatically notifying the user of the upgrade when the application is accessed.

With respect to claims 10 (currently amended), 12 (original) and 13 (original), the limitations recited in these claims are analogous to the limitations recited in claims 1, 3 and 4, respectively (see D'Souza and Parthesarathy as applied to claims 1, 3 and 4 above).

With respect to claims 19 (currently amended), 21 (original) and 22 (original), the limitations recited in these claims are analogous to the limitations recited in claims 1, 3 and 4, respectively (see D'Souza and Parthesarathy as applied to claims 1, 3 and 4 above).

9.   Claims 2, 5-9, 11, 14-18, 20 and 23-27 are rejected under 35 U.S.C. 103(a) as being

unpatentable over D'Souza in view of Parthesarathy as applied to claims 1, 10 and 19 above,

respectively, and further in view of U.S. Pat. No. 6,266,788 to Othmer et al. (art of record,

"Othmer" herein).

With respect to claim 2 (original), D'Souza in view of Parthesarathy does not expressly

disclose receiving feedback from said user regarding said upgrade version.

However, Othmer discloses receiving bug reports and other feedback from a user who is

testing an application (see, for example, column 1, lines 30-40). The feedback is automatically

received, classified and characterized (see, for example, FIG. 2), such that bug-tracking systems

and engineers can be automatically notified according to the nature of the feedback (see, for

example, column 2, lines 40-57).

It would have been obvious to one of ordinary skill in the art at the time the invention

was made to supplement the application upgrade and certification process of D'Souza and

Parthesarathy with the feedback features taught by Othmer, for the purpose of automatically

informing the engineers of problems affecting the certification process.

With respect to claim 5 (currently amended), D'Souza in view of Parthesarathy does not

expressly disclose the limitation wherein said feedback is in a form of responses to a

questionnaire which is caused to be displayed on a display device of said user.

However, Othmer discloses receiving bug reports and other feedback from a user who is

testing an application (see, for example, column 1, lines 30-40). The feedback is automatically

received, classified and characterized (see, for example, FIG. 2), such that bug-tracking systems

and engineers can be automatically notified according to the nature of the feedback (see, for example, column 2, lines 40-57). Othmer further discloses the limitation wherein said feedback is in a form of responses to a questionnaire which is caused to be displayed on a display device of said user (see, for example, column 13, lines 8-36, which shows an exemplary incident report that includes user comments, i.e. in response to a questionnaire displayed for the user).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to supplement the application upgrade and certification process of D'Souza and Parthesarathy with the feedback features taught by Othmer, for the purpose of automatically informing the engineers of problems affecting the certification process.

With respect to claim 6 (currently amended), D'Souza in view of Parthesarathy in view of Othmer further discloses migrating said upgrade version to said user in response to said feedback (see, for example, D'Souza, column 14, lines 21-30, which shows migrating the upgrade version after the certification or testing is complete).

With respect to claim 7 (original), D'Souza in view of Parthesarathy in view of Othmer further discloses the limitation wherein said migration is accomplished by changing a pointer reference from said first network address to said second network address (see, for example, D'Souza, column 15, lines 45-60, which shows routing the load, i.e. by changing a pointer reference, from the first network address to the second network address).

With respect to claim 8 (original), D'Souza in view of Parthesarathy in view of Othmer further discloses the limitation wherein said first and second network addresses are located at a single network server site (see, for example, D'Souza, column 16, lines 31-37, which shows that

the second network address may be located locally in the server cluster of the first network

address).

With respect to claim 9 (original), D'Souza in view of Parthesarathy in view of Othmer

further discloses the limitation wherein said first and second network addresses are located at

different network server sites (see, for example, D'Souza, column 16, lines 31-37, which shows

that the second network address may be located remotely to the server cluster of the first network

address).

With respect to claims 11 (original), 14 (currently amended), 15 (currently amended), 16

(original), 17 (original) and 18 (original), the limitations recited in these claims are analogous to

the limitations recited in claims 2, 5, 6, 7, 8 and 9, respectively (see D'Souza, Parthesarathy and

Othmer as applied to claims 2, 5, 6, 7, 8 and 9 above).

With respect to claims 20 (original), 23 (currently amended), 24 (currently amended), 25

(original), 26 (original) and 27 (original), the limitations recited in these claims are analogous to

the limitations recited in claims 2, 5, 6, 7, 8 and 9, respectively (see D'Souza, Parthesarathy and

Othmer as applied to claims 2, 5, 6, 7, 8 and 9 above).

Conclusion

10.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure. U.S. Pat. No. 6,681,389 to Engel et al. discloses a method for providing scaleable

restart and backout of software upgrades for clustered computer. U.S. Pub. No. 2001/0042073 to

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MY

Michael J. Yigdall
Examiner
Art Unit 2122

mjy

JOHN CHAVIS
PATENT EXAMINER
ART UNIT 2124

Saether et al. discloses a method and system for automatically updating the version of a set of files stored on content servers.

11.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Yigdall whose telephone number is (571) 272-3707. The examiner can normally be reached on Monday through Friday from 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.